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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,086	11/29/2000	Robert T. Durst JR.	150-058RP	9655

7590

01/30/2004

MR. WILLIAM FRITZ
NEOMEDIA TECHNOLOGIES, INC.
2201 SECOND STREET
SUITE 600
FORT MYERS, FL 33901

EXAMINER

KUMAR, UTTAM

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,086

Applicant(s)

DURST ET AL.

Examiner

Uttam Kumar

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The following office action is in response to U.S. patent application number 09/726,086. Claims 1-20 have been examined in view of the specification. The summary of the response is as follows:

Rejected Claims: 1-20
Claim Objections: 17
Allowed Claims:

This action is non-final.

Claim Objections

1. Claim 17 is objected to because of the following informalities: Line 20 reads "retrieving the stored the web-based...." It should read "retrieving the stored web-based...." Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim **18** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Line 2 is written as "receiving as a composer interface, to selections by the publisher." It is unclear what the applicant is trying to teach with this limitation.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1-20** are rejected under 35 U.S.C. 102(b) as being anticipated by Stork et al (U.S. 5,781,914), hereinafter referred to as Stork.

3. As to claims **1 and 10**, Stork discloses a system and method for converting documents, with links to other electronic information, between hardcopy and electronic formats that teaches:

- A publisher interface, responsive to publisher inputs, for generating a code, or a graphic including a bar code, associated with a web-based document including the content (column 4, lines 31-52; lines 65-67).
- A user interface, that may be connected to the internet, for receiving the code inputted by the user to access the corresponding content selected by the user (column 4, lines 6-16; column 7, lines 1-5; column 8, lines 10-16).
- A web server that may be connected to the Internet for storing the web-based document, responsive to the inputted code, for providing the web-based document including the selected content (column 1, lines 27-40; column 4, lines 12-16; column 8, lines 10-16).

As to claim **2 and 11**, Stork teaches content storage device for storing the web-based document generated by a publisher associated with the code and retrievable by the web server (column 6, lines 56-67).

As to claim **3 and 12**, Stork teaches a composer interface, responsive to selections by the publisher, for generating the web-based document including publisher content, and for associating the generated code with the web-based document (column 7, lines 36-54).

As to claim **4 and 13**, Stork teaches

- A code scanner, operated by a user, for scanning the code, and for generating a corresponding code signal (column 7, lines 1-17)
- Wherein the web server, responsive to the code signal as the inputted code, provides to the user the web-document associated with the scanned code (column 7 line 60-column 8 line 22).

As to claim **5**, Stork teaches the code is a graphic capable of being read by the code scanner (column 5, lines 48-50).

As to claim **6 and 14**, Stork teaches the graphic is printable by a publisher to be placed on a physical document provided to the user (column 7, lines 29-35).

As to claim **7**, Stork teaches

- The graphic includes a bar code (column 4, lines 42-45)
- Wherein the code scanner is a bar code reader for scanning the graphic, including the bar code (column 7, lines 3-5).

As to claims **8, 9, 15 and 16**, Stork teaches the web based document includes a plurality of panes as sub-pages of the web-based document and each of the plurality of panes corresponds to respective sets of publisher-specified content (column 8, lines 17-22). The cited reference teaches the publishing of web documents. In claims 8, 9, 15 and 16, applicant is merely describing the use of frame technology in web documents, which is well known in the art.

As to claim **17**, Stork teaches:

- Storing the content in a web based document on a web server (column 1, lines 27-40; column 4, lines 12-16).
- Generating, in response to publisher inputs through a publisher interface, a graphic including a bar code, with the graphic being associated with the content (column 4, lines 31-52; lines 65-67).
- Outputting the graphic with the bar code onto a physical document (column 7, lines 29-35).
- Receiving, at a user interface, the graphic with the bar code on the physical document (column 7, lines 43-53).
- Responding to the inputted graphic with the bar code at a web server (column 8, lines 10-22)
- Retrieving the stored web-based document including the selected content corresponding to the inputted graphic (column 6, lines 56-67).

As to claim **18**, as best understood by the examiner, Stork teaches

- Generating the web-based document including publisher content (column 7 line 60-column 8 line 22)
- Associating the generated graphic with the web-based document (column 5, lines 1-30)

As to claim **19**, Stork teaches

- Scanning the graphic with the bar code using a bar code scanner, operated by a user (column 7, lines 1-17)
- Generating a code signal corresponding to the scanned graphic (column 7, lines 1-26)
- Responding to the code signal as the inputted bar code to provide to the user the web-document associated with the scanned bar code (column 7 line 60-column 8 line 22).

As to claim **20**, Stork teaches printing the graphic as a printed document and placing the printed graphic onto a physical document to be provided to the user for inputting to receive the content (column 4, lines 30-52; column 7, lines 29-35).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. 5,337,362, Gormish et al

Method and Apparatus for Placing Data onto Plain Paper

This patent describes coding an electronic document onto digital paper

U.S. 5,111,445, Wang

System for encoding Data in Machine Readable Graphic Form

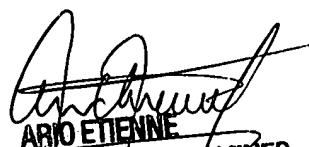
This patent describes converting documents into bar code.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uttam Kumar whose telephone number is 703-305-0719. The examiner can normally be reached on M-Th 7:30-5; Every other Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Uttam Kumar
Art Unit 2157
January 15, 2004


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100